

In claim 1, the split screen means is responsive to player location means such that when two players' game locations are within a preset range, the separate portions of the graphical display for the two players are merged into a single portion of the graphical display, and when the two players' game locations are outside the preset range, the graphical display for the two players is split into separate portions.

→ The Examiner has recognized that the automatic split screen feature claimed in claim 1 is not taught or suggested by Naka et al. It is the Examiner's opinion that Stamper et al. and Curchod teach an automatic split-screen means and that it would be obvious to combine the references. It is respectfully submitted that (a) neither of the secondary references teaches split screen means which is responsive to player location, (b) Stamper et al. is not a multiplayer game, (c) Curchod is non-analogous art, and (d) there is no incentive to combine the references.

→ With regard to the first point, both of the secondary references link the split screen mode to game token location rather than player location. In Stamper et al. the game token is a pinball and in Curchod the game token is a golf ball. Claim 1 specifically requires that the split screen be responsive to player location. Neither of the secondary references teaches or suggest such and thus, even if the references could be combined as

suggested by the Examiner, the combination would not result in the game claimed in claim 1.

With regard to the second point, Stamper et al. is not a multiplayer game as claimed in claim 1 or as disclosed in Naka et al. It is the quintessential single player game, pinball. Thus, it is highly speculative that it could be combined in any way with a multiplayer game in any meaningful way.

With regard to the third point, a golf simulator is not analogous to a video game. None of the classes and subclasses in the classification or field of search in Naka et al. can be found in the classification or field of search in Curchod. Thus, it is far from apparent how the golf simulator of Curchod would be combined with the "multi-player video game with cooperative mode and competition mode" of Naka et al.

With regard to the fourth point, no incentive for attempting a combination of Naka et al. with either of the secondary references can be found in the references or in the art in general. The Examiner's stated incentive is simply to create "a better multiplayer electronic game".

→ To draw on hindsight knowledge of the applicant's Specification, when the prior art does not contain or suggest the knowledge, is to use the invention as a template for its own

reconstruction--an illogical and inappropriate process in which to determine patentability. In the recently decided In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999), the Federal Circuit noted that

"[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." Id. at 1617

The fact that the claimed invention is easy to understand does not remove the Examiner's duty of providing evidence of a teaching or motivation. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." Id. The Examiner's stated motivation of making the game better is not evidenced by any of the art provided, and is clearly a construct solely of the Examiner; there is no evidence in the prior art to support the stated motivation.

→ In claims 7 and 10, the split screen means is responsive to the game logic such that the graphical screen is split into separate portions when the players are acting individually and the

separate portions are merged into a single portion when the players are acting jointly.

→ There is no suggestion in any of the art of record to split a screen depending on whether players are acting individually or jointly. As mentioned above, the only use of a split screen in the art is linked to game token location. Also, as mentioned above, there is no incentive to combine the references in any meaningful way.

Claims 2-6 depend from claim 1; claims 8 and 9 depend from claim 7; and claims 11 and 12 depend from claim 10. It is therefore submitted that claims 1-12 are allowable over the art of record.

→ Independent claim 13 includes "means for requiring the two players to act jointly". Independent claims 18 and 20 include "means for requiring the two players to act cooperatively". The Examiner has stated that these means are disclosed in Naka et al. The Naka et al. reference was well known to the Applicant at the time this application was drafted and claims 13, 18, and 20 were drafted with the intention of avoiding these references.

At pages 3-4 of the instant application, the Naka et al. reference is described as follows: "[T]he game disclosed in this patent does not require any cooperation among the players and the

"cooperative mode" does not involve cooperation among players.... The "cooperative mode" disclosed in the [Naka et al.] patent is when one player takes control of more than one character on the game field. In the [Naka et al.] patent "cooperative mode" means that two characters perform the same actions in response to the control by a single player." Emphasis added. See, also, Naka et al. Col. 19, lines 1-13 and lines 54-59. Naka et al. prevents two players from playing in a cooperative mode.

In each of the claims 13, 18, and 20, the joint or cooperative action is required of the players, not of characters under control of a single player. It is respectfully submitted, therefore, that each of these claims clearly distinguishes over the Naka et al. reference and that nothing in Naka et al. would suggest this type of game play. Moreover, even if one misinterprets the meaning of "cooperative", Naka et al. does not require any kind of cooperative play. The so-called "cooperative mode" disclosed by Naka et al. is entered when one player falls behind and is not required.

Claims 14-17 depend from claim 13 and are allowable for the same reasons as claim 13.

All of the arguments made regarding claims 1-12 as to lack of incentive to combine also apply to claims 13-17.

Claim 18 identifies the cooperative action required as being "selected from the group consisting of both players operating on the same object at the same time, each player operating on a different object at the same time, one player operating on a first object before the other player operates on said first object, one player accomplishing one task while the other player accomplishes another task, one player accomplishing a first task before the other player accomplishes a second task."

— The Examiner has not addressed the specific limitations of claim 18. It is respectfully submitted that these limitations are neither taught nor suggested by the art of record. Moreover, all of the arguments made regarding claims 1-12 as to lack of incentive to combine also apply to claim 18.

Claim 20 specifies, in addition to requiring both individual and cooperative action, that "neither player can complete the game without the other player also completing the game." Naka et al. does not meet the limitation of requiring cooperation between two players. Although Naka et al. prevents a novice player or an inattentive player from losing by a wide margin, it certainly allows one player to win, i.e. to complete the game without the other player completing the game. Moreover, all of the arguments made regarding claims 1-12 as to lack of incentive to combine also apply to claim 20.

Claim 21 depends from claim 20 and all of the arguments made regarding claim 20 apply to claim 21.

Claim 19 depends from claim 18 and is allowable for the same reasons as claim 18. Claim 19 also stands rejected under 35 U.S.C. §103(a) as obvious over Naka et al. in view of either Stamper et al. or Curchod further in view of Logg.

Arguably, Logg's teaching of one player opening a door before another player can pass through it would read on "one player accomplishing a first task before the other player accomplishes a second task." However, Logg specifically states that the character in possession of the key may open the door. Log, therefore, does not require any of the actions listed in claim 19.

All of the arguments made regarding claim 18 also apply to claim 19.

In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. A. Gallagher', written over a horizontal line.

Thomas A. Gallagher  
Reg. #31,358  
Attorney for Applicant(s)

65 Woods End Road  
Stamford, CT 06905  
(203) 329-9898

September 20, 2000